

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM R. KENNEDY and JOHN M. KENNEDY

Appeal No. 2001-1567
Application No. 09/044,455

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 4-6, 8-12, 14-16, 18 and 19, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of sealing off a mine passageway (claims 1, 2, 4-6, 8 and 9) and a method of sealing a stopping installed in a mine passageway (claims 10-12, 14-16, 18 and 19). A substantially correct copy of the claims under appeal is set forth in the appendix to the appellants' brief.¹

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wencley 1990	4,914,883	Apr. 10,
Kennedy 1972	1,283,304	July 26,
	(Gr. Britain)	
RHH Foam Systems Inc. Brochure (1996) (RHH Brochure)		

¹ The minor errors noted are: (1) in claim 1, line 15, and claim 10, line 9, the phrase "said gaps and" should read --said gaps, and --; (2) in claim 4, line 6, the word "a" should be --the--; (3) Claim 8 is dependent on canceled claim 7 not claim 6; and (4) Claim 18 is dependent on canceled claim 17 not claim 16.

Claims 1, 2, 4-6, 8, 10-12, 14-16 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kennedy in view of the RHH Brochure.

Claims 9 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kennedy in view of the RHH Brochure as applied to claims 1 and 10 above, and further in view of Wencley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed November 21, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 16, filed August 30, 2000) and reply brief (Paper No. 18, filed January 4, 2001) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of the evidence of obviousness presented by the examiner, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal.² Accordingly, we will not sustain the examiner's rejection of claims 1, 2, 4-6, 8-12, 14-16, 18 and 19 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would

² Accordingly there is no need for us to consider the 37 CFR § 1.132 declaration of William R. Kennedy filed on February 15, 2000. We note that the examiner never treated this declaration even though it was argued in the amendment filed on February 15, 2000, the brief and the reply brief.

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the method claims under appeal require an injector to be held in or within about one-half inch of gaps formed in a stopping installed in a mine passageway and injecting a fluent sealing material under pressure into those gaps to form a seal yieldable under stress to maintain its integrity in the event of a mine convergence. However, it is our view that these limitations are not suggested by the applied prior art. In that regard, while Kennedy does teach caulking gaps formed in a stopping installed in a mine passageway and the RHH Brochure does teach that fluent sealing material under pressure can be used to fill voids, cracks and crevices, the combined teachings of Kennedy and the RHH Brochure do not teach or

suggest using the fluent sealing material of the RHH Brochure to fill gaps in the stopping of Kennedy by holding an injector in or within about one-half inch of gaps. While the fluent sealing material injector gun of the RHH Brochure could be held in or within about one-half inch of the stopping gaps of Kennedy, we see no specific teaching, suggestion or motivation in any of the applied prior art to do so.³

³ We have also reviewed the reference to Wencley additionally applied in the rejection of claims 9 and 19 but find nothing therein which makes up for the deficiencies of Kennedy and the RHH Brochure discussed above.

In our view, the only suggestion for modifying Kennedy in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 1, 2, 4-6, 8-12, 14-16, 18 and 19.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 4-6, 8-12, 14-16, 18 and 19 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
))	
)	
)	
)	BOARD OF PATENT
LAWRENCE STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 2001-1567
Application No. 09/044,455

Page 9

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

Appeal No. 2001-1567
Application No. 09/044,455

Page 10

JVN/jg